

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

in re Patent Application of

Atty SCS-550-455
Dkt.

C# M#

DIJKSTRA

TC/A.U. 2181

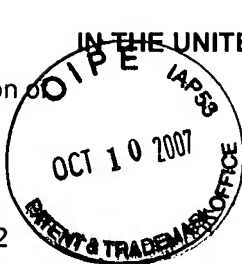
Serial No. 10/633,362

Examiner: J. Moll

Filed: August 4, 2003

Date: October 10, 2007

Title: ADDRESS GENERATION



JFW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

☐ **Correspondence Address Indication Form Attached.****Fees are attached as calculated below:**

Total effective claims after amendment **42** minus highest number
previously paid for **42** (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$

Independent claims after amendment **2** minus highest number
previously paid for **3** (at least 3) = 0 x \$210.00 \$0.00 (1201)/\$0.00 (2201) \$

If proper multiple dependent claims now added for first time, (ignore improper); add
\$370.00 (1203)/\$185.00 (2203) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this
paper and attachment(s)
One Month Extension \$120.00 (1251)/\$60.00 (2251)
Two Month Extensions \$460.00 (1252)/\$230.00 (2252)
Three Month Extensions \$1050.00 (1253)/\$525.00 (2253)
Four Month Extensions \$1640.00 (1254)/\$820.00 (2254)
Five Month Extensions \$2,230.00 (1255)/\$1115.00 (2255) \$

Terminal disclaimer enclosed, add \$130.00 (1814)/ \$65.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$ 0.00

Assignment Recording Fee \$40.00 (8021) \$ 0.00

Other: \$ 0.00

TOTAL FEE \$ 0.00

☐ **CREDIT CARD PAYMENT FORM ATTACHED.**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.
By Atty: Stanley C. Spooner, Reg. No. 27,393

Signature: 



UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

DIJKSTRA

Atty. Ref.: 550-455; Confirmation No. 5128

Appl. No. 10/633,362

TC/A.U. 2181

Filed: August 4, 2003

Examiner: J. Moll

For: ADDRESS GENERATION

* * * * *

Mail Stop Appeal Brief – Patents

October 10, 2007

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PETITION TO COMMISSIONER

Appellants respectfully petition the Commissioner to direct the Primary Examiner, Alfred Kindred, to withdraw the Notification of Non-Compliant Appeal Brief mailed September 10, 2007 (Paper No. 20070904) (the “Notification”) because the originally submitted Appeal Brief fully meets the requirements of the rules.

Although not cited in the Notification, 37 CFR §41.37(c)(1)(v) requires a summary of claimed subject matter which is a “concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, and to the drawing, if any, by reference characters.”

It is noted that the requirement is an “explanation” of the subject matter defined in the independent claims and that the word “concise” is only a modification of the word “explanation.” Thus, in each instance, Appellants are required first to provide an “explanation” and only then make that explanation “concise.”

Moreover, the rule also requires that the explanation refer to the specification by page and line number and to the drawing and reference characters, if any. Thus, the “explanation” is required to be in the form of references to portions of Appellants’ specification, page and line number and drawing reference numbers first and then to be made as concise as possible.

It is a matter of public record that there is no requirement that a patent application be a “concise explanation” of the invention. It instead must be a full and complete explanation of the best mode of practicing the invention and must be fully enabling to those having ordinary skill in the art. More often than not, patent specifications are not a “concise” explanation of the claimed invention.

In the subject application, the invention is a data processing apparatus comprising a number of claimed components and claimed interrelationships between those components. While Appellants could identify a single page and line number where a component is first mentioned in the specification, that reference to the specification would not necessarily meet the requirement of providing an “explanation,” even though the Primary Examiner may consider that to be a “concise” discussion of the subject matter.

Appellants’ first duty to the Board in preparing an Appeal Brief is to comply with the rule and, as quoted above, the rule requires an “explanation” first and then a “concise” explanation if possible. Appellants have fully complied with the rule and thus the originally submitted Appeal Brief meets all requirements of the Code of Federal Regulations.

In telephone discussions with members of Group 2100 in the past, it has been pointed out that that group and the appeals specialist in particular (Lynne H. Browne) have consistently applied requirements which are not supported in the Code of Federal Regulations. In the past,

they have objected to the language “elsewhere in the specification” and have also objected to the inclusion of more arguments than are recited in the Final Rejection.

The Board of Patent Appeals and Interferences has consistently indicated that there is no defect in referencing “elsewhere in the specification” because in virtually all instances, there are additional references to the claimed subject matter throughout the patent application. The Board has also held that there is no difficulty with having more argument headings than there are bases for rejection in the appeal from action, apparently because often the arguments may be utilized in conjunction with responses to more than one basis of rejection.

It is the undersigned’s experience that, over the last several years, group 2100 has attempted to enforce numerous rules and interpretations which are not supported by the Board of Patent Appeals and Interferences or the rules and the Commissioner’s relief from this misapplication of the patent rules is respectfully requested.

Specifically, in the above case, Appellants’ undersigned representative spoke with Mr. Patrick Nolan who is the Board of Patent Appeals and Interferences specialist regarding the format required for Appeal Briefs. During a telephone interview conducted on September 24, 2007, Mr. Nolan confirmed that the first obligation of an appellant with respect to the Appeal Brief is to provide an “explanation” of the claimed subject matter, regardless of how long or involved that explanation may be. A secondary aspect of the rule is that it is desirable that that explanation be made as concise as possible, but that conciseness is limited to a very great degree by the specification and whether all discussions of the limitation and interrelationships of that limitation with other limitations – if the claimed elements and interrelationship between elements is spread over a number of pages, then the “concise explanation” will necessarily have to be referenced over a number of pages.

Mr. Nolan suggested that it is not the Board's intent to reduce or eliminate the necessary explanation in the name of "conciseness." Mr. Nolan sympathized with Appellants and especially Appellants' dealing with a group which apparently misunderstands the requirement of the rule. Mr. Nolan suggested filing a response pointing out that the referenced portions of the specification extending over multiple pages are identified as necessary to understanding the claimed element and the claimed interrelationship of that element with other elements of the claim. Appellants hereby make that representation to the Commissioner with respect to this Appeal Brief and this can be seen by the following example.

Primary Examiner Kindred states in the Notification that an example of a "not concise" explanation occurs on page 5, lines 2-3 of the Brief which comprises the explanation of step b) "generating a shifted operand from one of said operands." The concise explanation of this "generating" step is indicated in the Appeal Brief as being discussed from page 14, line 18 to page 17, line 4 and elsewhere in the specification.

It is noted that the claimed "generating" step requires "one of said operands" and thus this refers to the previous "receiving" step which establishes the operands associated with the instruction (specification page 14, line 18). The address generation stage 200 receives operands as noted on page 14, line 25, and the description of at least one embodiment of structure performing these method steps is disclosed in Figures 6A and 6B. It is noted that the discussion of Figures 6A and 6B extends from page 14, line 18 through page 17, line 21. The interrelationship between the components disclosed in the figures explains the "generating" step of providing a "shifted operand" from "one of said operands" discussed earlier in the claim.

It is submitted that the cited three pages are necessary to properly explain Appellants' "generating" step and its interrelationship with the other claimed elements and thus Appellants

have met the rule requirement of an "explanation." Appellants have made the explanation as concise as possible and have not encumbered the explanation with further citations of other discussions in the specification of the "generating" step.

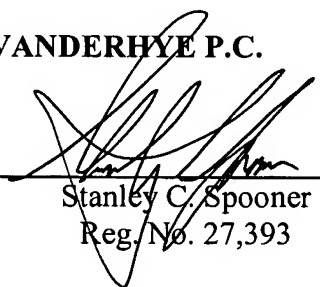
Accordingly, the Commissioner is respectfully petitioned to grant Appellants' relief from the requirement of the Notification sent by Primary Examiner Alfred Kindred in this application. As indicated by Mr. Nolan, the first obligation is an "explanation" and Appellants' Appeal Brief as filed meets that requirement. The second advisory is that the explanation be as "concise" as possible given that Appellants must refer to the specification and drawings as originally filed and these may not be as concise as desired. It is respectfully requested that the Commissioner direct Primary Examiner Kindred to withdraw the Notification of Non-Compliant Appeal Brief and more closely adhere to the rules regarding Appeal Briefs.

Having responded to all objections in the Notification of Non-Compliant Appeal Brief, it is respectfully requested that the Appeal Brief be forwarded to the Examiner for response on the merits or allowance of the application.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


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